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10/512,078	11/05/2004	Fabio Franceschi	023349-00298	3042
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EXAMINER THAKUR, VIREN A				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DCIPDocket@arentfox.com
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Office Action Summary

Application No.

10/512,078

Applicant(s)

FRANCESCHI, FABIO

Examiner

VIREN THAKUR

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7, 9-13, 15, 19 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7, 9-13, 15, 19 and 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. In view of the amendments to the claims, the rejection of claims 1-4, 7-13, 15-23 under 35 U.S.C. 112, first paragraph, and claims 1-4, 7-13, 15-23 under 35 U.S.C. 112, second paragraph have been withdrawn.
2. The objection to claims 16 has been withdrawn as a result of the cancellation of the claim.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1,2,7,15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Favre (CH688686) in view of Cavalluzzi (US 3985069), as further evidenced by Ranz (US 2615384), van der Lijn et al. (US 4860645) Moerlini et al. (US 3411431) and le Granse (US 4550024), and in further view of Masek (WO0056629), Doglioni (WO02076270), Lagneaux (EP0007876) and Rodth (US 2778739).

Regarding claim 1, Favre has been applied for the reasons given in the previous Office Action, mailed May 14, 2009.

Claim 1 differs from Favre in specifically reciting that the first container is a self-contained and fully enclosed pod made of filter paper or other similar filter material and contains a powdered infusion substance and wherein this self-contained pod is revealed after a removable sheet covering the pod and the entire capsule has been removed.

Favre already teaches placing an infusion material within container (71) and a soluble/dissolvable material in the second container (7) and also teaches a removable cover (41) that covers the top of the capsule but is silent in the first container (71) being comprised of a self-contained and fully enclosed pod made of filter paper or other similar filter material.

Nevertheless, Cavalluzzi teaches that it has been advantageous to fully enclose the product contained within a filter paper material, for the purpose of preventing the upward migration of coffee during the brewing stages (column 6, lines 4-9). Ranz, van der Lijn, Moerlini and Le Granse all evidence that it was conventional in the art to completely enclose an infusible material within a filter pod. Ranz (figure 5) has been cited as further evidence of a fully enclosed pod comprising an extractable substance,

as does van der Lijn et al. (figure 9 and column 3, lines 51-59). Ranz even teaches that the enclosed, self-contained filter pod can contain coffee, tea or chocolate. In view of these teachings, it is noted that it would have been obvious to have modified Favre and fully enclose the filter compartment so as to create a filter pod, as taught by Cavalluzzi, for the purpose of preventing the upward migration of coffee during the brewing stages (column 6, lines 4-9). Additionally, the references to Ranz and van der Lijn et al., further evidence that it has been a conventional expedient in the art to completely seal a compartment comprising filter paper. Obviously, complete containment of the material within the filter paper pod, as taught by Ranz and van der Lijn et al. would have prevented the contents within the filter paper portion from falling out after removal of the lid. It is further noted that Moerlini et al. has been relied on as further evidence that it was a conventional concept in the art to provide a pre-made pod comprised of filter paper, which is then placed into a container/cartridge that is then used for extracting the contents from the filter paper pod (column 2, lines 41-61 and figure 4). Le Grasse has been cited as further evidence that a fully enclosed container made of filter paper (figure 1, items 3 and 4) which is subsequently inserted into a second container for the purpose of extracting the contents therein, has been a conventional expedient for providing an extractable substance within a cartridge. To therefore modify Favre and self-contain the material within the filter paper by employing an enclosed filter paper pod, as taught by Ranz and van der Lijn et al. would thus have been an obvious substitution of one conventional expedient for containing an extractable substance for another conventional

expedient for containing an extractable substance, for the purpose of preventing accidental spilling of the contents therein.

Claim 1 newly recites that the bottom surface of the second container has a hole, covered by a seal of suitable material designed to be opened or pierced and to re-close the hole when the capsule is removed after being used.

It is noted that Favre already teaches piercing a hole in the second container and even teaches employing a material that is pierceable (see figure 9). It is noted that the apparent difference between figure 9 of Favre and that of applicant's hole and seal is the particular structure of the hole. As can be seen in applicant's figure 6, the pierceable material appears to be of the same material as that of the remainder of the bottom of the container. Therefore, it appears that the hole is not present in the bottom of the container until after the point at which a portion of the bottom of the container has been pierced by a piercing element. Nevertheless, this is similar to the structure taught by Favre. That is, the point at which the hole would have been present after piercing results in the formation of a hole (figure 9) with the sealing portion still retained on the container (figure 9, item 26). It is also noted that applicant's disclosure indicates that this seal can be an integral part of the bottom surface of the cartridge. Therefore, in light of the above and since the claims do not further limit a separate seal or an integral seal, Favre teaches an integral seal.

It appears that Favre might differ in not showing a particular demarcation or specific location on the cartridge where the hole is formed. Masek already teaches a seal covering a hole (figure 2, item 16 and figure 3, item 19). Doglioni (figure 1, item 14

and figure 2, item 5) teach providing a specified hole and location that has been perforated for the purpose of facilitating piercing of the cartridge as does Lagneaux (figure 1, items 16, 20 and 22). Rodth further teaches openings in the cartridge that employ a sealing material that is also integral with the cartridge body (figure 1, item 12 and figure 6, items 12 and 53). The references to Doglioni, Lagneaux and Rodth are all analogous in that they teach openings in coffee cartridge containers that employ sealing members that are both integral with and separate from the cartridge. Therefore, to modify Favre, if necessary, and employ a second sealing element or a demarcation indicating a hole with a seal covering the hole would thus have been obvious to one having ordinary skill in the art, for the purpose of facilitating opening of the cartridge for dispensing the beverage.

In any case, Favre does not appear to teach that the seal is designed to reclose the hole when the capsule is removed after being used.

Nevertheless, Masek has been relied on to teach employing a seal over the portion of the cartridge into which a hole is formed, which further results in reclosing of the hole so as to retain the contents contained therein once the cartridge has been used (page 4, lines 32-37 and page 5, lines 7-11). Therefore, the art recognized the advantage of employing a sealing portion that can reseal an opening that has been created by a piercing element, for piercing a coffee cartridge. To therefore modify the combination and employ a sealing element as taught by Masek would therefore have been obvious to one having ordinary skill in the art, for the purpose of preventing the contents within the cartridge from spilling out after the cartridge has been used.

Claims 2, 7 and 15 are rejected for the reasons given in the previous Office Action, mailed May 14, 2009.

6. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1-2, 7, 15, above, and in further view of Brody (The Encyclopedia of Food Packaging Technology).

Claims 3 and 4 differ from the previously applied combination of references in reciting that the first container is attached to the second container by gluing (claim 3) or ultrasound sealing (claim 4).

It is noted the particular recited method by which the first container was fixed to the second container has been a conventional method for adhering one item to another. In any case, with respect to ultrasound sealing, it is noted that Brody teaches that it has been conventional in the art to use ultrasonic sealing for its art recognized and applicants' intended purpose. Regarding gluing, it is noted that by heat sealing, Favre is in essence gluing the first container to the second container, since as a result of heat sealing the melted material acts like a glue to thus create the seal. It is further noted, however, that once it was taught to employ a conventional sealing technique such as heat sealing to therefore substitute one conventional sealing method for another conventional sealing method would have been an obvious matter of choice and/or design for the purpose of achieving the desired sealing properties between the two containers.

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1, 2, 7, 15 above, and in further view of Cortese (US 6792980) and Astle (US 5789251).

Claim 9 recites that the seal constitutes a portion of the bottom surface of the cartridge. It is noted that Favre already employs a continuous bottom surface of the cartridge, and thus already seals a hole in the cartridge by employing a seal that constitutes a bottom portion of the cartridge. Claim 9, in combination with claim 1, recites that the seal, which is constitutes a portion of the bottom of the cartridge which also is designed to reseal the opening when the cartridge is removed.

It is noted that the limitation "constitutes a portion of the bottom surface" reads on a seal that is separate from and integral with the bottom of the container. In any case, it is noted that Masek already teaches sealing mechanisms that constitute a bottom portion of the cartridge (figure 4, item 30). To further expedite prosecution, however, Cortese has been relied on to teach a seal continuous with a portion of the cartridge, which further prevents back-flow of any liquid after the cartridge has been used (figure 9 and column 5, lines 23-32). This concept has been further evidenced by Astle (figure 5 and column 3, lines 17-31). The art thus teaches that it has been conventional to provide a self-sealing type mechanism at the opening of a container to seal any contents remaining within the container, and wherein the seal comprises a portion of the container. Since Masek already teaches this concept, to modify the previous combination and employ a seal that can subsequently open to allow for the removal of the contents within the container and subsequently close to seal the container again,

would thus have been obvious to one having ordinary skill in the art, for the purpose of preventing accidental spilling of the contents within the container.

8. Claims 10-11, 19, 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 9 above, and in further view of Kataoka (US 20020148772 A1), Bernhardt (US 4340138), Harriss (US 2965501) and Petrofsky et al. (US 5045333).

Regarding claims 10 and 21-23, the combination as applied to claim 1, teaches a rigid second container made of a food safe plastic material and a first container comprising a pod made of a filter material that fully encloses the infusible material. Masek, Doglioni, Rodth, Cortese and Astle have been relied on as discussed above to teach a seal that constitutes a portion of the bottom surface of the cartridge, as recited in claim 10.

Regarding the matching of the annular outer edge of the filter paper pod being fixed to a matching annular protuberance on the plastic cartridge, it is noted that Favre already teaches that the filter paper container is secured to a matching protuberance on the second container, as shown in figure 2a. Kataoka, Bernhardt, Harriss and Petrofsky et al. have only been relied on as evidence that it has been conventional in the art to arrange a first container within a second container such that an annular edge of a first container mates with an annular protuberance of the second container for the purpose of securing the two containers together. For instance, Kataoka (Figure 3, item

10) and Bernhardt (Figures 1 and 3) teach that it was a conventional expedient in the art to mate an annular edge with an annular protuberance for the purpose of securing a first smaller container into a second larger container. Harriss (Figure 3) and Petrofsky et al. (Figure 2) further evidence this concept. To therefore modify the combination, if even necessary, and employ a conventional mating structure, as taught by the art taken as a whole, would have been obvious to one having ordinary skill in the art for the purpose of securing a first container within a second container.

Regarding claim 11, Favre disclose wherein the protective cover material is removably placed over the top of the filter paper pod and mates with the annular protuberances of the cartridge, as shown in figure 2b. Cavalluzzi (figure 3, item 30) and Ranz (figure 5, item 105) further evidence the concept of a self-contained pod comprised of filter material that further comprises a removable seal thereon.

Claim 19 is rejected for the reasons given above with respect to claim 9.

9. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1, 2,7,15, above, and in further view of Cai (US 6777007).

Regarding claim 12, it is noted that Favre teaches making coffee and espresso drinks and wherein the substance in the first container is an extractable substance, while the substance in the second container is a soluble substance. The claim differs from Favre in specifically reciting wherein the material in the first container comprises powdered coffee.

It is noted however, that Favre already recognized employing a combination of a soluble and infusible material wherein the container (71) can include an infusible material and container (7) can include a soluble (dissolvable) material (see column 3, lines 31-39 and lines 45-55). Once the art recognized placing an infusible material in the filter pod and a dissolvable material in the container, the particular conventional ingredients placed in each of these containers would have been an obvious matter of choice and/or design.

Additionally, however, it is noted that Ranz and Cavalluzzi already teach coffee within the filter pod. Additionally, as evidenced by Cai '007 in figure 11, for instance, item 33 is powdered milk and item 33a is ground (or powdered) coffee (also see column 9, line 61 to column 10, line 10). By putting the coffee grounds on top of the powdered milk, Cai '007 teaches preventing clogging of the filter paper (column 10, lines 6-10). To therefore modify the combination and employ coffee grounds in the first compartment and powdered milk in the second would have been obvious for the purpose of preventing clogging of the filter.

Response to Arguments

10. On page 9 of the response, applicants urge that the combination does not teach a self-contained and fully enclosed pod made of filter paper or other similar filter material placed inside the second container and wherein the self contained and fully

enclosed pod containing the powdered infusion substance is revealed after the removable sheet has been removed and a bottom surface of the container has a hole, covered by a seal designed to be opened or pierced and to reclose the hole when the capsule is removed after being used.

Applicant further urges on page 11 that the structure taught by Cavalluzzi is not the same as a self-contained and fully enclosed pod made of filter paper or other similar material. This argument has been considered but is not persuasive. It is noted that Cavalluzzi teaches that item 22 and item 26 can be made from filter paper (column 4, lines 30-34). Regarding the upper enclosing member, it is noted that on column 6, lines 4-11, Cavalluzzi teaches employing an underlay of filter material positioned on the opposite side of the partition disc. Furthermore, Ranz provides further evidence of a fully enclosed pod made of paper that has apertures (column 4, lines 20-35 and lines 50-57), which are thus flexible, since they are shaped into a desired shape.

11. Regarding the filter pod being revealed after removal of the removable sheet, it is noted that Favre already teaches employing a removable sheet (figure 12b). Thus, by employing the advantages of a self-contained filter pod, as taught by Cavalluzzi, Ranz and van der Lijn et al., it would have been obvious to one having ordinary skill in the art that the removal of the sheet would have revealed the self-contained filter pod.

12. Applicant further urges on page 11 of the response that the filter cup of Cavalluzzi is a rigid cup, not made of filter material.

This argument has been considered but is not persuasive. It is noted that Cavalluzzi clearly teaches that the container is made from filter paper (column 4, lines 30-34). Also, it is noted that Favre also already teaches a container made from filter paper, which thus would have been flexible. Favre is only silent in employing a self enclosing pod comprising filter paper. Cavalluzzi, Ranz and van der Lijn et al. teach enclosing a filter paper material to retain the contents within the filter paper container. Regarding the cup being rigid, this argument is not persuasive since filter paper employed for coffee filtration has been known in the art to carry a degree of flexibility. Favre, Cavalluzzi and Ranz all teach employing filter paper for this same purpose and therefore it would have been obvious that pods made of filter paper would have possessed a degree of flexibility.

13. In summary, it is noted that Favre is only missing the particular enclosed filter pod, which the art teaches has been advantageous for the purpose of retaining the contents within the filter material. Regarding the seal that re-closes after the capsule has been removed, the art teaches re-closing a seal after it has been punctured has been advantageous for coffee cartridge applications, as evidenced by Masek and Cortese. It is further noted that if one desired to reclose an opening which had been punctured, Astle further evidences that it has been a conventional concept to provide a seal that can re-close for this purpose. Therefore, to employ a seal that recloses after puncturing would have been obvious for its art recognized function of preventing the contents of the cartridge from accidentally spilling out. Regarding the particular

arrangement of coffee in the filter pod with a soluble substance such as powdered milk in the second (larger) container, it is noted that Favre already recognized employing a combination of a soluble and infusible material wherein the container (71) can include an infusible material and container (7) can include a soluble (dissolvable) material. Therefore, once the art recognized placing an infusible material in the filter pod and a dissolvable material in the container, the particular conventional ingredients placed in each of these containers would have been an obvious matter of choice and/or design.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. WO 02080744 discloses a seal that opens and can close when infusing the contents with a liquid for making a beverage such as coffee (figures 4-6).

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VIREN THAKUR whose telephone number is (571)272-

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6694. The examiner can normally be reached on Monday through Friday from 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571)-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Steve Weinstein/
Primary Examiner, Art Unit 1794

/V. T./
Examiner, Art Unit 1794